

REMARKS

Claims 1-28, 30 and 31 are pending in the present application. In summary of the outstanding Office Action, claims 1-28, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,572,442 (Schulhof et al.) in view of U.S. Patent No. 6,272,636 (Neville et al.). Acknowledgment of the drawings as formal and Applicant's priority claims is respectfully requested.

First of all, Applicants would like to thank Examiner for his time and consideration in discussing Applicants present case and the helpful input provided during the interview of July 26, 2005. Applicants have attempted to address Examiner's concerns expressed during the interview and have provided the response and amendments herein in view of the Office Action and discussions that occurred during the interview. Thus, reconsideration of the outstanding rejections to the claims is respectfully requested in view of the previous interview and the following remarks and amendments.

Claim rejections under 35 U.S.C. §103

Claims 1-28, 30 and 31 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Schulhof et al. in view of U.S. Patent No. 6,272,636 (Neville et al.).

As a preliminary matter, the Office Action states that "Applicant is of the opinion that Neville et al. cannot be combined with Schulhof et al." Applicant would like to note, however, that although the combination of Neville et al. and Schulhof et al. may be improper, no such argument was made in Applicant's previous response. Rather, in the previous response, Applicant noted that all the limitations of the claims are not disclosed in either Schulhof et al. or Neville et al., even if combined. Applicant respectfully maintains this position for the same reasons provided in the previous response as well as the additional reasons provided below.

Regarding claim 1, the Office Action states that "after a purchase step, Neville et al. explicitly states that a customer is allowed full execution of content without limitation." However, without conceding the propriety of the rejection of claim 1 prior to the present amendment, claim 1 as amended recites a particular way of initiating a purchase transaction that is not taught or suggested by Neville et al. or Schulhof. In particular, claim 1 calls for:

“...automatically receiving unrestricted playback selection information regarding a previously recorded music selection from the at least one customer location to at a central controller system when the previously recorded music selection has been played a predetermined number of times at a customer location or an indication is made by the customer that the music is selected for unrestricted playback, whichever occurs first.”

First, it is important to note that the withholding of an unlock key as described in Neville et al., to which the Office Action refers, is to prevent access to a “metered digital product” Col. 13, lines 14-26, and not to prevent access to any unrestricted use or playback. Essentially, the metered digital product of Neville, et al. is only available for use until the evaluation period has expired Col. 13, lines 30-35. The only language in Neville et al. that discusses unrestricted access to a digital product states “Essentially, a purchase step would remove any execution control features, and allow full execution of the product without limitation.” Col. 17, lines 3-5. However, this does not describe how the purchase is initiated or completed. In contrast, claim 1 as recited above describes automatically receiving unrestricted playback selection information in a particular manner not described in Neville et al. or Schulhof.

Secondly, Neville et al. states that the “purchase step may be incorporated into the execution control procedures.” Col. 17, lines 1-2. However, this purchase step is after evaluation of software that has “execution control,” that “includes authorization to execute at a remote clearinghouse site, thereby preventing local, i.e., user, manipulation of a digital product.” Col. 16, lines 62-65. Claim 1 recites “previously recorded music selections, that were previously recorded by the at least one customer in a storage medium at a location of the customer ...” which is opposed to executing demo software at a remote clearinghouse. Thus, according to claim 1, the “previously recorded music selections” are stored at the “customer household,” rather than programs being executed or stored at a “remote clearinghouse site” as Neville et al. states.

Thus, for at least the reasons above, Applicant respectfully submits that all the limitations of claim 1 are not taught or suggested by Schulhof et al. or Neville et al.

Regarding claims 2-18, 20, 21, 23, 26, 27 and 31, the Office Action gives the same reason as for claim 1 in rejecting these claims. Thus, Applicant submits that all the limitations of claims 2-18, 20, 21, 23, 26, 27 and 31 are not taught or suggested by Schulhof et al. for at least the same reasons above as for claim 1 as amended.

Furthermore, regarding claims 8 and 19, the Office Action contends that the element of “generating a permanent enabling code for inclusion with said permanent recorded music selections to thereby enable unrestricted playback,” is disclosed by Schulhof et al. at column 9, lines 27-37. However, Schulhof et al. is merely describing using a “known data encryption scheme, such as a public key system (e.g. RSA) where the subscriber’s system is registered to the program materials at the time the materials are transferred to the subscriber.” Col. 9, lines 31-35. There is no discussion of a “permanent enabling code,” or including such a code with the music selections. Rather, public key encryption requires both a public and private key and includes encryption of the content using the public key and decryption using the private key. There is no mention in Schulhof et al. how or when these public and private keys are transferred and whether it is with the music content or not. Therefore, Schulhof et al. does not describe “generating a permanent enabling code for inclusion with said permanent recorded music selections to thereby enable unrestricted playback.”

Thus, for at least the reasons above, Applicant respectfully submits that all the limitations of claims 8 and 19 are not taught or suggested by Schulhof et al. or Neville et al.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 1-28, 30 and 31 are not taught or suggested by Schulhof et al., Neville et al., or any combination thereof, for the same reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 1-28, 30 and 31 is earnestly solicited.

CONCLUSION

Applicant believes that the present Amendment is responsive to each point raised by the Examiner in the office action and Applicants submit that claims 1-28, 30 and 31 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner’s earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason,

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Applicant's undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for the Examiner's continued rejection in light of the Applicant's arguments presented herein. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicant's undersigned representative would very much appreciate a telephone conference to discuss these issues.

Date: _____



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